

RESPONSE AND REMARKS

I. REJECTIONS UNDER SECTION 101

In the Office Action, Claims 64-79 were rejected under 35 U.S.C. §101. The Office Action asserted that the Claims failed to meet the “useful, concrete and tangible results” test.

II. RESPONSE REMARKS REGARDING REJECTIONS UNDER SECTION 101

The rejections under Section 101 have been carefully considered. Claims 64-79 have been amended to more distinctly claim the claimed invention. For the reasons given, and under the authorities cited, below, it is respectfully asserted that amended Claims 64-79 are directed to patentable subject matter under Section 101.

The Federal Circuit has recently held that the “‘useful, concrete and tangible result’ inquiry” for evaluating subject matter patentability is no longer the proper test to apply. *In re Bilski*, 545 F.3d 943, 959-60 (Fed. Cir. 2008) (*en banc*).

Rather, although there may be other ways of demonstrating claimed subject matter as patent eligible under Section 101, the Federal Circuit has held that “[a] claimed process is *surely* patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *In re Bilski*, 545 F.3d at 954 (emphasis added).

For the reasons given below, it is respectfully asserted that amended Claims 64-79 meet the *Bilski* machine-or-transformation test. First, both amended independent Claims 64 and 74 claim limitations that are tied to a particular machine. In particular, amended Claims 64 and 74, for example, claim “[a] server-based shipping management computer system comprising at least one server computer” Further, amended Claims 64 and 74 claim that “said server computer compris[es] a computer usable medium having a computer readable program code embodied therein” It is respectfully asserted that the server-based shipping management computer system that comprises a server computer as claimed in amended Claims 64 and 74 comprises a particular machine under the *Bilski* machine-or-transformation test. It is therefore respectfully asserted that amended Claims 64 and 74, and therefore the Claims

dependent on them, namely 65-73 and 75-79, are therefore directed to patentable subject matter under Section 101.

Further, amended independent Claims 64 and 74 expressly claim transformation and therefore meet the Bilski machine-or-transformation test. For example, amended Claim 64 claims, for example, "transforming the user input into a first shipping rate" Amended Claim 74 similarly claims a transformation, claiming "transforming an input by a user ... of a particular shipping date and package specifications for a particular package, into a first day on which a first carrier would deliver the particular package"

Because amended Claims 64 and 74 expressly claim transformation and therefore meet the Bilski machine-or-transformation test, it is respectfully asserted that amended Claims 64 and 74, and therefore the Claims dependent on them, namely 65-73 and 75-79, are accordingly directed to patentable subject matter under Section 101.

III. REJECTIONS UNDER SECTION 103(a)

In the Office Action, Claims 64-67 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kara et al. (U.S. Patent No. 6,233,568; "Kara") in view of InterShipper; (Newsbytes Article, Internet Update; "InterShipper"), UPS® On Call Air Pickup (www.apps.ups.com; "UPS On Call"), UPS® Service Guide (www.ups.com; "UPS") and FedEx® Services (www.fedex.com; "FedEx"). Office Action, Topic No. 7, p. 4.

In rejecting Claims 64-67, although the Office Action states that "Kara discloses ... [d]etermining multiple shipping rates ... for a first carrier ... [and] [d]etermining multiple shipping rates for a second carrier ..." (Office Action, Topic No. 8, p. 4), the Office Action concedes that "Kara disclose[s] the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of rates for each carrier that includes rates of different services (Column 11, lines 1-13)." Office Action, Topic No. 9, p. 5. In order to compensate for the stated failure of Kara, the Office Action asserts that "InterShipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3)." Office Action, Topic

No. 9, p. 5. The Office Action then asserts that “[i]t would have been obvious ... to modify Nicholls and Kara to display every method possible to ship a package, as disclosed by InterShipper, in order to find the cheapest shipping rate (See Page 1).”

Office Action, Topic No. 9, p. 5.

Notably, “Nicholls” is mentioned in the Office Action (see Office Action, Topic No. 9, p. 5), but is not further identified or referenced in the formal grounds for rejection.

In rejecting Claims 64-67, and Claims 68-79, the Office Action further concedes that “Kara discloses receiving shipping information, however fails to disclose the [sic] receiving the shipping date from the user. Office Action, Topic No. 10, p. 5. In order to compensate for the stated failure of Kara, the Office Action then asserts that “UPS discloses its on-call pick up which allows a user to schedule a pick-up with UPS, therefore receiving a shipping date.” Office Action, Topic No. 10, p. 5. The Office Action further asserts that “[i]t would have been obvious ... to modify Kara, to have the ability to schedule a shipping date by the user, as taught by UPS.” Office Action, Topic No. 10, p. 5. The Office Action then cites KSR as support for the assertion that the Claims 64-67 are a “combination of familiar elements according to known methods” Office Action, Topic No. 10, p. 5.

The Office Action rejected Claims 68-79 under 35 U.S.C. §103(a) as being unpatentable over Kara, InterShipper, UPS On Call, UPS, and FedEx as applied to Claim 64 above, and further in view of Barnett et al. (U.S. Patent No. 6,369,840; “Barnett”). Office Action, Topic No. 12, p. 6.

In rejecting Claims 68-79, although the Office Action states that “Kara discloses ... [d]etermining multiple shipping rates ... for a first carrier ... [and] [d]etermining multiple shipping rates for a second carrier ...” (Office Action, Topic No. 13, p. 6), the Office Action concedes that “Kara disclose[s] the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of rates for each carrier that includes rates of different services (Column 11, lines 1-13).” Office Action, Topic No. 14, p. 6. In order to compensate for the stated failure of Kara, the Office Action asserts that “InterShipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major

shippers (See Internet Update Article Page 1, Paragraphs 1-3).” Office Action, Topic No. 14, p. 6. The Office Action then asserts that “[i]t would have been obvious ... to modify Nicholls and Kara to display every method possible to ship a package, as disclosed by InterShipper, in order to find the cheapest shipping rate (See Page 1).” Office Action, Topic No. 14, pgs. 6-7.

Notably, “Nicholls” is again mentioned in the Office Action (see Office Action, Topic No. 14, p. 6), but is not further identified or referenced in the formal grounds for rejection.

In rejecting Claims 68-79, the Office Action further concedes that “Kara discloses receiving shipping information, however fails to disclose the [sic] receiving the shipping date from the user. Office Action, Topic No. 15, p. 7. In order to compensate for the stated failure of Kara, the Office Action then asserts that “UPS discloses its on-call pick up which allows a user to schedule a pick-up with UPS, therefore receiving a shipping date.” Office Action, Topic No. 15, p. 7. The Office Action further asserts that “[i]t would have been obvious ... to modify Kara, to have the ability to schedule a shipping date by the user, as taught by UPS.” Office Action, Topic No. 15, p. 7. The Office Action then cites KSR as support for the assertion that the Claims 64-67 are a “combination of familiar elements according to known methods” Office Action, Topic No. 15, p. 7.

With respect to the rejection of Claims 68-79, the Office Action further concedes that “... Kara does not specifically disclose the rates being calculated with respect to day and time, according to the shipping date.” Office Action, Topic No. 16, p. 7. In view of the above-conceded failure of Kara, the Office Action asserts though, that “[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. It would have been obvious ... to include the time sensitive ‘urgency’ services, as disclosed by FedEx® and UPS®, in order to ship thing [sic] and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance.” Office Action, Topic No. 16, p. 7 (citing FedEx, page 1).

The Office Action then concedes that “Kara, InterShipper, UPS® and FedEx® fail to disclose the use of a simultaneous display with [sic] shows the date and time of services ...” Office Action, Topic No. 16, pg. 7. In order to compensate for the

conceded failure of the other cited references, the Office Action then asserts that "Barnet [sic] discloses the use of a calendar which can be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9)." Office Action, Topic No. 16, pgs. 7-8. The Office Action then asserts that "[i]t would have been obvious ... to have the display of rates of Kara, InterShipper, UPS® and FedEx® with respect to day and time, include the day and time, as disclosed by Barnett, in order to provide a single integrated display that allows a user to order or purchase a system based on the calendar day and time." Office Action, Topic No. 16, p. 8 (citing Barnett, column 2).

IV. RESPONSE REMARKS REGARDING SECTION 103(a) REJECTIONS

The rejections under Section 103(a) have been carefully considered.

As mentioned above, Claims 64-79 have been amended to more distinctly claim the claimed invention.

A Declaration under 35 U.S.C. §132 by David Allison Bennett, currently with iShip Inc. (a fully owned subsidiary of United Parcel Service of America, Inc., which is a fully owned subsidiary of United Parcel Service, Inc.), one of the assignees of the above-identified patent application ("Bennett Declaration" or "Bennett Decl."), is referred to herein, and a copy of which is filed concurrently herewith.

It is respectfully asserted, for the reasons given and authorities cited below, and in view of the evidence provided by the Bennett Declaration supporting the assertions herein of non-obviousness, that the application is in condition for allowance.

For the reasons given and under the authorities cited below, it is respectfully asserted that Claims 64-79 are patentable over the cited references and are in condition for allowance.

A. NONE OF THE CITED REFERENCES, EVEN WHEN CONSIDERED IN COMBINATION, DISCLOSE TRANSFORMING USER INPUT INTO SHIPPING RATES FOR MULTIPLE DELIVERY SERVICES FOR MULTIPLE CARRIERS IN RESPONSE TO RECEIVING A SET OF PACKAGE SPECIFICATIONS AND A SHIPPING DATE AND ACCORDING TO THE SHIPPING DATE AS CLAIMED BY CLAIM 64

For the reasons given below, it is respectfully asserted that the limitations claimed by amended Claim 64 for determining shipping rates for multiple delivery services for multiple carriers according to a particular shipping date are not disclosed by the cited references, even when those references are considered in combination, and that Claim 64 and the Claims dependent on it, are therefore patentable and in condition for allowance. In particular, Claim 64 recites:

in response to receiving the set of package specifications and the indication of the shipping date:

transforming the user input into a first shipping rate, said first shipping rate being a rate that a first carrier would charge to deliver said package to said destination according to a first delivery service and according to the shipping date,

transforming the user input into a second shipping rate, said second shipping rate being a rate that said first carrier would charge to deliver said package to said destination according to a second delivery service and according to the shipping date,

transforming the user input into a third shipping rate, said third shipping rate being a rate that a second carrier would charge to deliver said package to said destination according to a third delivery service and according to the shipping date,

transforming the user input into a fourth shipping rate, said fourth shipping rate being a rate that said second carrier would charge to deliver said package to said destination according to a fourth delivery service and according to the shipping date, and

simultaneously displaying said first, second, third, and fourth shipping rates to a display device operable with the remote client computer;

The Office Action states that “[t]he examiner agrees that there is no one reference which teaches this, hence why a 103 rejection is applied.” Office Action, Topic No. 18, p. 9. However, with regard to the above-cited claimed limitations, the Office Action asserts that “UPS has a service which allows the use of scheduling a pick-up of a package. When a pick up is scheduled, and the user enters in the scheduled

pick-up date, then the user is submitting a shipping date.” Office Action, Topic No. 18, p. 8. The Office Action then asserts that “Kara discloses receiving a set of parcel specifications and determining the shipping cost. UPS discloses scheduling a shipping, and discloses calculating rates based on things like shipping date (schedule a pick up), therefore the combination of references would provide claims as recited.” Office Action, Topic No. 18, p. 9. Because the UPS reference does not disclose user input of a shipping date, the above-mentioned discussion by the Office Action is taken to refer to the UPS On Call reference, which discloses an input field for a Pickup Date.

It is respectfully asserted that the assertion of the Office Action that “UPS discloses scheduling a shipping, and discloses calculating rates based on things like shipping date” reads more into the UPS On Call reference than is actually disclosed by that reference.

In particular, it is respectfully asserted that none of the cited references, including UPS On Call, disclose transforming user input into shipping rates for multiple delivery services for multiple carriers according to a particular shipping date as claimed by amended independent Claim 64. Further, for the reasons given below, it is respectfully asserted that the UPS On Call reference shows that the UPS On Call reference *does not* disclose, as claimed by amended independent Claim 64, transforming user input into shipping rates for multiple delivery services *for multiple carriers according to a particular shipping date*.

The UPS On Call reference discloses a pickup service, namely, the UPS® “On Call Air Pickup” service, and discloses input fields for scheduling a pickup of a shipment. UPS On Call, ¶1. According to the UPS On Call reference, the UPS® “On Call Air Pickup” service may be used in support of various UPS® Air delivery services, including UPS Next Day Air Early A.M.SM, UPS Next Day Air®, UPS Next Day Air SaverSM, UPS 2nd Day Air A.M.TM, UPS 2nd Day Air®, UPS Worldwide ExpressSM, and UPS Worldwide ExpeditedSM. UPS On Call, ¶2. It is respectfully asserted that although the UPS® “On Call Air Pickup” service may be used in support of various UPS® Air delivery services, the UPS® “On Call Air Pickup” service is not itself a delivery service.

According to the UPS On Call reference, the UPS® “On Call Air Pickup” service may be used to schedule a pickup of a shipment for the various above-mentioned

UPS® Air delivery services. For that purpose, the UPS On Call reference shows input fields in a section labeled “Scheduling Information” for a “Pickup Location”, a “Pickup Date”, a time for a “Shipment [to be] Ready at”, a “Pick Up by” time, and a “Continue” button. UPS On Call, “Scheduling Information.” The UPS On Call reference explains that “UPS On Call Air Pickup service gives you the convenience of having your shipment picked up.” UPS On Call, “Scheduling Information.” That is, it is respectfully asserted that the input fields on the UPS On Call reference are provided so that a Pickup can be scheduled for shipment; the UPS On Call reference does not disclose that there would be any costs associated with the Pickup and does not indicate that any costs would be displayed if a user were to complete the above-mentioned input fields to schedule a Pickup and then click the “Continue” button under the “Scheduling Information” block of the reference. See also, e.g., Bennett Decl., ¶ 20; Bennett Decl., Exhibit H. Rather, in order to obtain costs, it appears that a user would need to activate the “Quick Cost Calculator” link, such as shown on the UPS On Call reference. See UPS On Call, ¶ 3; see also, e.g., Bennett Decl., ¶ 20; Bennett Decl., Exhibit H.

Moreover, and for the reasons given further below, it is respectfully asserted that the UPS On Call reference does not indicate that the information under the “Scheduling Information” section of the page must have first been input in order to click the “Quick Cost Calculator” link in order to calculate a rate. See also, e.g., Bennett Decl., ¶¶ 22-23, 27-28, 31; Bennett Decl., Exhibit H; Bennett Decl., Exhibit J.

It is respectfully asserted that, using the same www.archive.org website that was apparently used by the Examiner to obtain the UPS On Call reference, it is possible to access an operational exemplar of the UPS® website page entitled “On Call Air Pickup.” See also, e.g., Bennett Decl., ¶¶ 6, 18; Bennett Decl., Exhibit H. It is respectfully asserted that accessing the operational exemplar of the UPS® website page entitled “On Call Air Pickup” confirms the above-mentioned absence of consideration of a Pickup Date in the calculation further to the UPS On Call reference of a shipping rate. See also, e.g., Bennett Decl., ¶¶ 32-33. More particularly, it is respectfully asserted, in view of the reasons given below, that the “Pickup Date” input field on the UPS On Call reference, asserted by the Office Action to be equivalent to a shipping date, does not

appear to be used by the exemplar "UPS Quick Cost Calculator™" page in calculating shipping rates as claimed by amended Claim 64.

It is respectfully asserted that when accessing the operational exemplar UPS® website "On Call Air Pickup" page, an operational exemplar "Quick Cost Calculator" Link is displayed. See, e.g., Bennett Decl., ¶¶ 20, 22. It is respectfully asserted that, whether or not data has been entered into all of the input data fields (including a Pickup Location, Pickup Date, Shipment Ready at time and Pick Up by time) on the operational exemplar UPS® "On Call Air Pickup" page, clicking on the operational exemplar "Quick Cost Calculator" Link on the operational exemplar UPS® "On Call Air Pickup" page will result in the display of another operational exemplar UPS® website page, entitled "UPS Quick Cost Calculator™." See, e.g., Bennett Decl., ¶¶ 22-23, 27-28, 31; Bennett Decl., Exhibit J.

It is respectfully asserted that the operational exemplar UPS® "UPS Quick Cost Calculator™" page as depicted in Exhibit J to the Bennett Decl., accessed from the operational exemplar UPS® "On Call Air Pickup" page, has an input section titled "ORIGIN" that provides input fields for an Origin Country and Postal Code; an input section titled "DESTINATION" that provides input fields for Destination Country, City and Postal Code, and that provides a Yes/No indicator for whether the Destination Address is a Residential Address; an input section titled "PACKAGE INFORMATION" that provides input fields for a Drop-off/Pickup selection, a Packaging Type, a Package Weight, and Package Dimensions; provides a "Calculate" button; and indicates that once the information for an item has been input, clicking the "Calculate" button will result in shipping charges being calculated. See also, e.g., Bennett Decl., ¶ 24; Bennett Decl., Exhibit J.

It is respectfully asserted that the operational exemplar UPS® "UPS Quick Cost Calculator™" page, accessed from the operational exemplar UPS® "On Call Air Pickup" page, does not provide any input field or other means for a user to indicate a shipping or pickup date. See also, e.g., Bennett Decl., ¶ 26; Bennett Decl., Exhibit J.

Further, it is respectfully asserted that the operational exemplar UPS® "[UPS] Quick Cost Calculator™" page may be displayed by clicking a "Quick Cost Calculator" link on any of the operational exemplar UPS® web pages for any of the various UPS®

delivery service web pages (e.g., UPS Next Day Air®, UPS Next Day Air Early A.M.SM, etc.). See also, e.g., Bennett Decl., ¶¶ 10, 15; Bennett Decl., Exhibits C, F and G. Yet further, it is respectfully asserted that those various UPS® delivery service web pages (e.g., UPS Next Day Air®, UPS Next Day Air Early A.M.SM, etc.) do not provide any Pickup Date or Shipping Date input fields. See also, e.g., Bennett Decl., ¶¶ 12, 17; Bennett Decl., Exhibits C and F.

Still further, as compared to the limitations of amended Claim 64, it is respectfully asserted that the operational exemplars of the UPS® “UPS Quick Cost Calculator™” webpage do not indicate that a calculation of a rate would consider any particular Pickup [or shipping] date, or that any Pickup [or shipping] Date must have been input, such as through the UPS® “On Call Air Pickup™” webpage, in order for a rate to be calculated. See also, e.g., Bennett Decl., ¶ 32; Bennett Decl., Exhibit J.

Yet further, it is respectfully asserted that inputting data into input fields of the operational exemplar UPS® website page entitled “UPS Quick Cost Calculator™” does not result in a calculation and therefore does not serve to indicate whether or not a rate for more than one delivery service at a time would have been calculated. See also, e.g., Bennett Decl., ¶ 33; Bennett Decl., Exhibits K and L.

Yet further still, it is respectfully asserted that the operational exemplar UPS® website page entitled “UPS Quick Cost Calculator™” does not indicate that a rate for any carrier other than UPS® would be calculated. See also, e.g., Bennett Decl., ¶ 34; Bennett Decl., Exhibit K.

As compared to the UPS On Call reference and even as compared to the consequent “UPS Quick Cost Calculator™” page as depicted in Exhibit J to the Bennett Decl., it is respectfully asserted that a calculation of a shipping rate according to a shipping date would be useful over the cited references in that such a calculation would facilitate consideration of different rules for calculating a rate where a service might charge a premium over a standard rate for the service, for example, to deliver on certain days of the week, for example, on a Saturday or Sunday, or on a holiday.

For the above-given reasons, it is respectfully asserted that the UPS On Call reference, even if considered in combination with the other cited references, does not

disclose, anticipate, teach or suggest the combination of limitations claimed by amended independent Claim 64.

It is therefore respectfully asserted that amended independent Claim 64, and the Claims dependent on it, namely, Claims 65-73 are non-obvious in view of the cited references and are therefore in condition for allowance.

B. NONE OF THE CITED REFERENCES, EVEN WHEN CONSIDERED IN COMBINATION, DISCLOSE IDENTIFYING DAYS OR DATES, AND/OR TIMES, BY WHICH A PACKAGE WOULD BE DELIVERED ACCORDING TO A SHIPPING DATE AS CLAIMED IN ONE WAY OR ANOTHER BY CLAIMS 68 AND 69, 72-74, 76 AND 79

It is respectfully asserted that the identifying of a day for delivery according to a particular shipping date as claimed by Claim 68 is not disclosed by any of the cited references, including the FedEx, UPS, UPS On Call and Barnett references. See Claims 72 and 73 for similar limitations. Further, it is respectfully asserted that the identifying of times for delivery according to a particular shipping date as claimed by Claim 69 is not disclosed by any of the cited references, including the FedEx, UPS, UPS On Call and Barnett references. See Claims 76 and 79 for similar limitations. Yet further, it is respectfully asserted that there is no disclosure in any of the cited references, including the FedEx, UPS, UPS On Call and Barnett references, of “transforming an input by a user through a particular remote client computer of a particular shipping date and package specifications for a particular package, into a [particular] day on which a [particular] carrier would deliver the particular package to a particular destination according to a particular shipping date, if [the particular] carrier were to deliver said package to said destination via a [particular] delivery service ...” as claimed by independent Claim 74.

With respect to the rejection of, among others, Claims 68, 69, 72-74, 76 and 79, the Office Action concedes that “... Kara does not specifically disclose the rates being calculated with respect to day and time, according to the shipping date” (Office Action, Topic No. 16, p. 7), but asserts instead, that “[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day.” Office Action, Topic No. 16, p. 7.

For the reasons given further below, it is respectfully asserted that the above-quoted rejections fail to set forth a *prima facie* case of obviousness of Claims 68, 69, 72-74, 76 and 79, and therefore the Claims dependent on them, namely Claims 70-71, 75, 77-78, as required for an obviousness rejection under MPEP §706.02(j) and MPEP §2143.

First, it is respectfully asserted that the asserted disclosure of the UPS and FedEx references as posited by the Office Action of "... specific services where they are guaranteed delivery by a certain time in the day" (Office Action, Topic No. 16, p. 7) fails to assert disclosure of the claimed limitations for: a.) identifying of a day for delivery according to a particular shipping date as claimed by Claims 68, 72, and 73 ; b.) identifying of times for delivery according to a particular shipping date as claimed by Claims 69, 76 and 79; or c.) "transforming an input by a user through a particular remote client computer of a particular shipping date and package specifications for a particular package, into a [particular] day on which a [particular] carrier would deliver the particular package to a particular destination according to a particular shipping date, if [the particular] carrier were to deliver said package to said destination via a [particular] delivery service ..." as claimed by independent Claim 74.

As compared to the above-mentioned limitations claimed by Claims 68, 69, 72-74, 76 and 79, and as described further below, it is respectfully asserted that the cited references do no more than provide a general description of delivery guarantees that do not indicate a particular date (or time) on which a particular delivery will be made.

It is respectfully asserted that the FedEx reference amounts to nothing more than a general description of various services offered by FedEx® and rules that FedEx® applies to shipments. Specifically, FedEx lists a number of FedEx® delivery services along with a brief description of each FedEx® delivery service. Further, it is respectfully asserted that the mere description or naming of a carrier's delivery service does not provide a shipping user with a definitive delivery date or delivery time.

For example, FedEx describes "FedEx Priority Overnight®" as providing "... delivery by 10:30 a.m. the next business day to thousands of U.S. cities in our primary service are (noon to most of the rest). Shipments may weigh up to 150 lbs., and

measure up to 119" length and up to 165" in length and girth combined ... Pickup and delivery Monday-Saturday". FedEx, p. 1.

It is respectfully asserted that the naming of the particular delivery service as an "Overnight" service might be interpreted by some shipping users to indicate that a package would be delivered the very next day. However, even though the particular FedEx® service is named an "Overnight" service, it is respectfully asserted that the guarantee for the "FedEx Priority Overnight®" service described in an the FedEx reference is actually for "the next business day." It is respectfully asserted that, depending on the day of the week and/or the date an item is shipped, the "next business day" may not be the very next day. Rather, depending on the day of the week and/or the date on which a particular item is shipped, and to some extent, on the time of shipment, the "next business day" not occur until several days after the shipment. For example, if an item is shipped on a Friday, the next business day would not occur until, at the earliest, three days later, on the following Monday. Further, if the following Monday happened to be a holiday, then the "next business day" would not occur until four days following shipment, on the following Tuesday.

Yet further, it is respectfully asserted that the time of delivery would depend on, among other things, the destination to which a particular item is to be delivered. As described in the FedEx reference, the "FedEx Priority Overnight®" service would provide "... delivery by 10:30 a.m. the next business day to thousands of U.S. cities in our primary service area (noon to most of the rest)." Therefore, it is respectfully asserted that, depending on the destination city, a shipment of an item using the "FedEx Priority Overnight®" service as described in the FedEx reference might be delivered by 10:30 a.m. the next business day, by noon the next business day, or possibly, some other time (in the case that the destination city was neither in the "primary service" or in "most of the rest").

As a further example of the differences between the name of a delivery service, the description of the associated guarantee, and the shipping-date-dependent delivery date, FedEx describes "FedEx Standard Overnight®" as providing "...delivery by 3:00 p.m. the next business day to thousands of U.S. cities in our primary service area (4:30 p.m. to most of the rest, Saturday delivery not available with this service). Shipment

may weigh up to 150 lbs., and measure up to 119" in length and up to 165" in length and girth combined." FedEx, p. 1.

As described above for the "FedEx Priority Overnight®" service, the "FedEx Standard Overnight®" is described as being associated with a "next business day" guarantee that would be shipping date/day-of-the-week dependent; the time of delivery is destination-city-dependent.

As yet another example of the differences between the name of a delivery service, the description of the associated guarantee, and the shipping-date-dependent delivery date, FedEx describes "FedEx 2Day(SM)" as providing "delivery by 4:30 p.m. the second business day (7:30 p.m. to residential destinations) within the continental U.S. Shipments may weight [sic] up to 150 lbs., and measure up to 119" in length and up to 165" in length and girth combined." FedEx, p. 1.

Still further, it is respectfully asserted that the FedEx reference is a non-enabling reference with respect to the claimed subject matter of the Claims of the present application; and can therefore not properly be used to support more than it actually discloses. See Reading and Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 652 (Fed. Cir. 1984) (finding a non-enabling promotional brochure cannot be used as a vehicle for qualifying a later filed patent as prior art). Therefore, for the above-given reasons, because the FedEx reference only names its services and give general guarantee descriptions but does not actually determine a shipping-date-dependent delivery date, it is respectfully asserted that the combination of limitations claimed by, for example, Claims 68, 69 and 74, are non-obvious in view of the FedEx reference, even when that reference is combined with the other cited references.

It is respectfully asserted for the reasons given further below that, similar to the FedEx reference, although the text of the UPS reference provides a description of each of its delivery services and the corresponding delivery guarantees, the UPS reference fails to disclose "... transforming an input ... into a [particular] day on which a [particular] carrier would deliver [a] particular package to a particular destination according to a particular shipping date ..." as claimed by Claim 74. And for the reasons given further below, neither does the UPS On Call reference.

According to the UPS and UPS On Call references, and as described above with respect to operational archived exemplars, the "Quick Cost Calculator" link appears to provide a user with the ability to click the link to obtain a calculation of shipping rates, and "availability and delivery times", for the particular service with which the link appears. However, for the reasons given below, it is respectfully asserted that the indication by the UPS and UPS On Call references of the "Quick Cost Calculator" link still fails to disclose "... transforming an input ... into a [particular] day on which a [particular] carrier would deliver [a] particular package to a particular destination according to a particular shipping date ..." as claimed, for example, by Claim 74.

In particular, for the reasons given further below, it is respectfully asserted that there is no disclosure in the UPS or UPS On Call references, or in operational exemplars of the UPS® "Quick Cost Calculator," that the referenced "availability and delivery times" would be determined according to a particular shipping date.

It is respectfully asserted that the UPS reference, as with FedEx, teaches that, even for "guaranteed" services, different delivery times may apply depending on the shipping and/or delivery particulars for shipping and delivering a particular parcel. For example, for the UPS Next Day Air Early A.M.® delivery service, even though UPS states "Guaranteed Overnight by 8 A.M.", UPS clarifies that "[y]ou get guaranteed delivery by 8:00 a.m. to major U.S. cities and by 8:30 a.m. to *most* other U.S. cities (9:00 a.m. or 9:30 a.m. on Saturday)..." (emphasis added). That is, in order for delivery to be "Guaranteed Overnight by 8 A.M.", assuming the delivery was to occur Monday through Friday, the delivery address would need to be in one of the "major U.S. cities;" in order for delivery to be guaranteed by 8:30 a.m., the delivery address, if not in one of the "major U.S. cities", would need to be in one of the "most other U.S. cities..." (emphasis added).

As another example of guarantee-dependency on shipping particulars, for the UPS Next Day Air® delivery service, even though UPS states "Guaranteed Overnight by 10:30 AM", UPS clarifies that delivery is guaranteed "...by 10:30 a.m., noon, or end-of-day the next business day *depending on destination* (noon or 1:30 p.m. on Saturdays)." (emphasis added). That is, according to UPS, delivery time would be dependent on the destination address and the day of the week shipped.

Further, the UPS reference teaches that, notwithstanding the name of a delivery service, delivery guarantees may depend on the day of the week on which shipping occurs. For example, some UPS® delivery services support Saturday delivery; whereas others do not; Sunday delivery options are not indicated in UPS for any of the UPS® delivery services. Compare, e.g., UPS, p. 2 (describing, for UPS Next Day Air Early A.M.®, both a Saturday Delivery option and a Saturday Pickup option) and UPS, p. 4 (describing, for UPS Next Day Air®, both a Saturday Delivery option and a Saturday Pickup option), with UPS, p. 6 (describing, for UPS® 2nd Day Air A.M.®, a Saturday Pickup option, but with no mention of a Saturday Delivery option).

That is, assuming that the delivery address is to one of "most metropolitan addresses" to which delivery would be "Guaranteed Two-Day by 12 Noon" (see, UPS, p. 6), if a package were sent on a Thursday via UPS® 2nd Day Air A.M.®, even though the delivery service name "UPS® 2nd Day Air A.M.®" may imply that the delivery would be made by the second day, a Saturday, following the Thursday shipment day, according to UPS, Saturday delivery would not be available. Because a Saturday delivery option is not available for the "UPS® 2nd Day Air A.M.®" delivery service, then delivery for a package sent on a Thursday using the "UPS® 2nd Day Air A.M.®" delivery service would not be available until the next day available for deliveries for the "UPS® 2nd Day Air A.M.®" delivery service -- which, because neither Saturday nor Sunday are indicated in UPS as delivery days for the "UPS® 2nd Day Air A.M.®" delivery service, would therefore not occur until, e.g., the following Monday, or if the following Monday were a holiday, then possibly not until the following Tuesday.

The above-described variations in delivery days and times for various UPS® delivery services as dependent on specific shipping and/or delivery parameters is evidence that the mere listing of a delivery service by name, and/or a general statement of guarantee, are not a conclusive indication of a delivery date or time for a particular parcel to be shipped to a particular address.

The UPS and UPS On Call references show a "Quick Cost Calculator" link on each separate UPS® delivery and pickup service page. See also, e.g., Bennett Decl., ¶¶ 10, 15, 20; Bennett Decl., Exhibits C, F and H. For example, for the UPS Next Day Air Early A.M.® delivery service, UPS states "Use the Quick Cost Calculator to

determine shipping rates, availability and delivery times for UPS Next Day Air Early A.M." UPS, p. 2. As another example, for the UPS Next Day Air® delivery service, UPS states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Next Day Air." UPS, p. 4. As a further example, for the UPS 2nd Day Air A.M.® delivery service, UPS states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air A.M." UPS, p. 6. Yet further, for the UPS 2nd Day Air® delivery service, UPS states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air." UPS, p. 8. For the UPS 3 Day Select® delivery service, UPS states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 3 Day Select." UPS, p. 10. For UPS Ground, UPS states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Ground Service." UPS, p. 12. Similarly, the UPS On Call reference states "Refer to the Quick Cost Calculator for the exact cost of your shipment." UPS On Call, ¶ 3.

However, it is respectfully submitted that neither the UPS Quick Cost Calculator link, nor the corresponding operational exemplars of the UPS® "Quick Cost Calculator™" webpage, as depicted, for example, in Exhibits D, G, and J to the Bennett Decl., appear to have provided any entry for a shipping date or any determination of any shipping-date dependent delivery date (or delivery time for that matter) in connection with any calculation of shipping rates, at least not during the time preceding the present invention. See, e.g., Bennett Decl., ¶¶ 12, 17, and 26.

Yet further, it is respectfully asserted that neither the UPS On Call reference nor the operational exemplars of the UPS® "Quick Cost Calculator™" webpage indicate that information under the "Scheduling Information" section of the UPS® "On Call Air Pickup™" webpage must have first been input in order in order to activate the "Quick Cost Calculator" link to calculate a rate. See also, e.g., Bennett Decl., ¶¶ 22-23, 27-28, 31; Bennett Decl., Exhibits H and J.

Further still, for the reasons previously described above, it is respectfully asserted that the operational exemplars of the UPS® "Quick Cost Calculator™" webpage do not indicate that a calculation of a rate would consider any particular Pickup [or shipping] date, or that any Pickup [or shipping] Date must have been input,

such as through the UPS® “On Call Air Pickup™” webpage, in order for a rate to be calculated. See also, e.g., Bennett Decl., ¶ 32; Bennett Decl., Exhibit J.

Because, as described above, there is no indication that any shipping or Pickup date is considered in calculating a rate (see also, e.g., Bennett Decl., ¶ 32), or that any shipping-date-dependent delivery date (or delivery time) would be determined by the UPS and UPS On Call references (or by the UPS® “Quick Cost Calculator™” webpage) (see also, e.g., Bennett Decl., ¶¶ 12, 17, and 26), it is therefore respectfully asserted that the UPS reference mention of “availability and delivery times” with respect to the “Quick Cost Calculator” link appears to be a reference to general availability and delivery times, not a delivery date and/or time that is identified or determined according to a particular shipping date as claimed, for example, by Claim 74.

As with the FedEx reference, it is respectfully asserted that the UPS and UPS On Call references are non-enabling references with respect to the claimed subject matter of the Claims of the present application, and can therefore not properly be used to support more than they actually disclose. See Reading and Bates, 748 F.2d at 652. Therefore, for the above-given reasons, because for the reasons given above there is no indication by the UPS , UPS On Call or FedEx references that a shipping-date-dependent delivery date and/or time is determined, it is therefore respectfully asserted that the UPS, UPS On Call or FedEx references do not disclose, anticipate, teach or suggest the combination of limitations claimed by, for example, Claims 68, 69, 72-74 and 79, and that those Claims are therefore non-obvious in view of the UPS, UPS On Call, and FedEx references, even when those references are combined with the other cited references.

C. INTERSHIPPER FAILS TO DISCLOSE A SIMULTANEOUS DISPLAY OF RATES, AND IT WOULD BE IMPROPER TO READ INTO INTERSHIPPER, A PRESUMPTION OF A SIMULTANEOUS DISPLAY OF RATES FOR MULTIPLE DELIVERY SERVICES PROVIDED BY VARIOUS CARRIERS THAT IS GLEANED FROM THE PRESENT APPLICATION

For the following reasons and authorities, it is respectfully asserted that the combination of limitations claimed by Claims 64 and 71 and therefore dependent Claims

65-73, are nonobvious in view of the combination of Intershipper with the other cited references because InterShipper, even when considered in combination with any of the other cited references, fails to disclose, anticipate, teach or suggest a simultaneous display of rates as claimed by independent Claim 64 (which recites "... simultaneously displaying said first, second, third, and fourth shipping rates to a display device") and dependent Claim 71 (which recites "...simultaneously displaying to the display device: (1) said first, second, third and fourth shipping rates; and (2) said first, second, third, and fourth delivery schedule indicia.")

Although the Office Action states that "Kara discloses ... [d]etermining multiple shipping rates ... for a first carrier ... [and] [d]etermining multiple shipping rates for a second carrier ..." (Office Action, Topic No. 13, p. 6), the Office Action concedes that "Kara disclose[s] the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of rates for each carrier that includes rates of different services (Column 11, lines 1-13)" (Office Action, Topic No. 14, p. 6). The Office Action asserts instead that "Intershipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3)." Office Action, Topic No. 14, p. 6.

The Office Action is apparently asserting that the below-quoted statements should be inferred to indicate that the InterShipper reference simultaneously displayed its results, and that the InterShipper reference included multiple delivery services offered by multiple carriers in its results:

Internet users can now get shipping rates from all major shippers in just a few seconds. Simply enter your origin, anywhere in the U.S. is OK, and destination, worldwide, along with your package weight and dimensions. The free service will return every method possible that you can use to ship your package and arrange the results in cost order, and color code the results by approximate transit time.
World Wide Web: <http://www.wwmerchant.com/iship>.

InterShipper, p. 1, ¶2.

For the reasons give and under the authorities cited below, it is respectfully asserted that both such inferences are equally misplaced and unsupported.

Importantly, the cited InterShipper reference is a publication, not a U.S. patent. As such, there is no presumption of enablement as to the disclosure of the cited InterShipper reference. Moreover, as to the Claims of the present application, it is respectfully asserted that the cited InterShipper reference is not enabling.

Although the cited InterShipper reference may qualify as a prior art reference under Section 103, it may only be used as a prior art reference "... for what is in fact disclosed in it." Reading and Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 652 (Fed. Cir. 1984) (finding a non-enabling promotional brochure cannot be used as a vehicle for qualifying a later filed patent as prior art).

In particular, it is respectfully asserted that, contrary to the inferences apparently asserted by the Office Action, the InterShipper reference never states that the InterShipper service would display its results simultaneously. Rather, the InterShipper reference states only that "[t]he free service will return every method possible that you can use to ship your package" InterShipper, p. 1, ¶2. It does not say that such returned "every method possible" will be simultaneously displayed.

The Office Action asserts that "[t]he InterShipper article may not explicitly disclose that the results are displayed on a computer screen, however InterShipper discloses all the information being given at one time." Office Action, Topic No. 19, p. 9. The Office Action further asserts that with "InterShipper ..., the user is provided with all the information at one time." Office Action, Topic No. 19, p. 9.

Contrary to the above-quoted assertion by the Office Action, it is respectfully asserted that InterShipper does not state that the results will be returned or displayed "all at one time," or that the user is provided "with all the information at one time." Therefore, it is respectfully asserted that, contrary to the holding of Reading and Bates that such a reference may only be used "... for what is in fact disclosed in it" (Reading and Bates, 748 F.2d at 652), the Office Action is improperly importing a perspective gleaned from the present application to impermissibly read a non-existing feature into the InterShipper reference and the combination of that reference with the other cited references. Cf. In re Mahurkar Patent Litigation, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995). Cf. also Reading and Bates, 748 F.2d at 652.

Because the Office Action relied on the InterShipper reference to provide the conceded missing link of a simultaneous display absent from the Kara reference, in view of the holdings of In re Mahurkar and Reading and Bates, it is therefore respectfully asserted that the complete absence from the InterShipper reference of any statement that the InterShipper service will display its results simultaneously, or even that it will return its results “all at one time” as suggested by the Office Action, is evidence that the combinations of limitations of Claims 64 and 71, and therefore dependent Claims 65-73, of the present application, are therefore non-obvious in view of the InterShipper reference, even when that reference is considered in combination with the other cited references.

Yet further, contrary to the inference apparently asserted by the Office Action that the InterShipper reference included multiple delivery services offered by multiple carriers in its results, it is respectfully asserted that the InterShipper reference never states that the InterShipper service would include multiple delivery services offered by the “major shippers.” To the contrary, the InterShipper reference specifically states that “Internet users can now get shipping rates from all major shippers ...”, not by multiple delivery services offered by multiple major shippers. It is respectfully asserted that the mention by the InterShipper reference that “[t]he free service will return every method possible that you can use to ship your package ...” (InterShipper, p. 1, ¶2) does not expressly state that the InterShipper reference would report a rate for multiple delivery services for multiple carriers. Rather, it is respectfully asserted that “every method possible” could be interpreted to merely refer to “all major shippers” mentioned by the InterShipper reference.

Accordingly, in view of the holdings of In re Mahurkar and Reading and Bates, it is therefore respectfully asserted that the complete absence from the InterShipper reference of an express statement that the InterShipper service would include multiple delivery services offered by the “major shippers” as suggested by the Office Action, is evidence that the combinations of limitations of Claims 64 and 71, and therefore dependent Claims 65-73, of the present application, are therefore non-obvious in view of the InterShipper reference, even when that reference is considered in combination with the other cited references.

D. NONE OF THE CITED REFERENCES, EVEN WHEN CONSIDERED IN COMBINATION, DISCLOSE SIMULTANEOUSLY DISPLAYING DELIVERY SCHEDULE INDICIA BY WHICH A PACKAGE WOULD BE DELIVERED ACCORDING TO A SHIPPING DATE AS CLAIMED IN ONE WAY OR ANOTHER BY CLAIMS 68, 69, 73-74, 76 AND 78-79

The Office Action indicates that it is relying on the UPS and FedEx references to disclose determining dates and times for shipments and is only citing Barnett, because "... Barnett is simply displaying them in a certain fashion." Office Action, Topic No. 21, p. 10. In particular, the Office Action asserts that although "Kara, InterShipper, UPS® and FedEx® fail to disclose the use of a simultaneous display with [sic] shows the date and time of services[,] Barnet[t] discloses the use of a calendar which can be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9)." Office Action, Topic No. 16, pg. 7-8. The Office Action further asserts that "[i]t would have been obvious ... to have the display of rates of Kara, InterShipper, UPS® and FedEx® with respect to day and time, include the day and time, as disclosed by Barnett, in order to provide a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2)." Office Action, Topic No. 16, p. 8.

However, for the reasons given, and under the authorities cited below, it is respectfully asserted that the above-quoted assertion of obviousness does not set forth a *prima facie* case of obviousness as required under MPEP §706.02(j) and MPEP §2143.

First, it is respectfully asserted for the reasons previously given above, that none of the Kara, UPS, UPS On Call and FedEx references disclose, anticipate, teach or suggest the limitations for identifying a day, date or times for delivery according to a particular shipping date as claimed in one way or another by Claims 68, 69, 72-74, 76 and 79, and therefore the Claims dependent on them, namely Claims 70-71, 75, 77-78. Therefore, it is respectfully asserted that the asserted combination of Barnett with the other cited references fails to set forth a *prima facie* case of obviousness of the claimed limitations.

Further, even if it were assumed for the sake of argument only, that one of the cited references disclosed the claimed limitations for identifying a day, date or times for delivery according to a particular shipping date, for the reasons given further below, it is respectfully asserted that adding Barnett to the combination of asserted references still does not disclose the combination of limitations for simultaneously displaying delivery schedule indicia by which a package would be delivered according to a shipping date as claimed in one way or another by Claims 68, 69, 73-74, 76 and 78-79.

It is respectfully asserted that the combination of limitations of Claims 68, 69, 73-74, 76 and 78-79, are predictive and determinative in nature – that is, the limitations recite a transformation of user input into a date and/or time for a future event (a delivery) according to a particular reference date (a shipping date) and claim simultaneously displaying scheduling indicia for such predictive events.

As compared to being predictive or determinative, or displaying scheduling indicia that is predictive in nature, it is respectfully asserted that Barnett does not identify or determine a date on which a particular event will occur with respect to a particular reference date, and does not display dates, that are predictive or determinative according to a particular reference date. Rather, it is respectfully asserted that Barnett merely reports dates and times on which events with pre-determined schedules are so scheduled to occur.

Yet further, as compared to the limitations of, for example, Claim 68, which by virtue of its dependency on Claim 64, claims limitations for simultaneously displaying shipping rates for each of multiple delivery services offered by each of multiple carriers, Barnett does not disclose any simultaneous display of rates (see e.g., Barnett, FIG. 9). In fact, it is respectfully submitted that Barnett does not disclose any display of rates by the Barnett system. Moreover, for the reasons previously given above, it is respectfully asserted that none of the cited references, including InterShipper, disclose a simultaneous display of rates for multiple delivery services offered by multiple carriers.

The Office Action asserts, though, that “Kara and InterShipper disclose calculating and displaying simultaneous display of rates of each carrier of each service, the UPS and FedEx references discloses determining dates and times for shipments.

Barnett discloses a calendaring system which displays things on a time and date basis.”

Office Action, Topic No. 21, p. 10.

For the reasons given above, it is respectfully asserted that the complete absence of the combination of limitations recited by Claims 68, 69, 72-74, 76 and 79, from the combination of references asserted by the Office Action, is strong evidence that the combination of limitations recited by Claims 68, 69, 72-74, 76 and 79, and therefore the Claims dependent on them, namely Claims 70-71, 75, 77-78, are therefore not obvious.

As compared to the cited references, it is respectfully asserted that one advantage of a shipping management computer system according to various embodiments of the system claimed in Claims 68, 69, 72-74, 76 and 79, and therefore the Claims dependent on them, namely Claims 70-71, 75, 77-78, is that such embodiments would allow for a simultaneous cross-comparison of the various schedules according to which a package would be delivered via multiple delivery services provided by each of a plurality of carriers. For example, such a system could be configured for simultaneously displaying: (1) the date on which UPS would deliver a package via an “overnight” delivery service; (2) the date on which UPS would deliver the package via a “second day” delivery service; (3) the date on which Federal Express would deliver the package via an “overnight” delivery service; and (4) the date on which Federal Express would deliver the package via a “second day” delivery service. It is respectfully asserted that such a display may be useful in allowing users to quickly compare the days on which a package would actually be delivered if the user were to ship the package on a particular shipping date via one of various delivery services. It is respectfully asserted that such an embodiment would be especially useful if different carriers have different policies regarding, for example, whether a package sent via overnight delivery on a Friday would be delivered on the next weekday (Saturday) or on the next business day (Monday).

For the above-given reason and authorities, it is respectfully asserted that the above-cited limitations of Claims 68, 69, 72-74, 76 and 79, and therefore the Claims dependent on them, namely Claims 70-71, 75, 77-78, are not disclosed, anticipated, taught or suggested by any of the cited references, whether considered alone or in

combination with any other cited reference, and are therefore non-obvious in view of the cited references, and are therefore in condition for allowance.

E. THE COMBINATIONS OF LIMITATIONS CLAIMED BY THE REJECTED CLAIMS MEET THE KSR TEST FOR NON-OBVIOUSNESS, YIELDING MORE THAN A SEPARATE APPLICATION BY THE ELEMENTS OF THE CLAIMED LIMITATIONS

In rejecting Claims 64-67, and Claims 68-79, the Office Action asserts that “[i]t would have been obvious ... to modify Kara, to have the ability to schedule a shipping date by the user, as taught by UPS.” Office Action, Topic No. 10, p. 5; Office Action, Topic No. 15, p. 7. The Office Action then cites KSR as support for the assertion that the Claims 64-67 are a “combination of familiar elements according to known methods” Office Action, Topic No. 10, p. 5; Office Action, Topic No. 15, p. 7.

In addition to the reasons previously given above why the cited references fail to disclose the combination of limitations claimed by the rejected Claims, it is respectfully asserted that the combinations of limitations claimed by the rejected Claims meet the KSR test for non-obviousness.

In KSR, the Supreme Court acknowledged that “... inventions in most, if not all, instances, rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” KSR, 127 S.Ct. at 1741. Accordingly, the KSR Court reiterated its caution against hindsight bias and *ex post* reasoning. KSR, 127 S.Ct. at 1742. Accord Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc., 2008 U.S. App. LEXIS 6786, *14-*15 (Fed. Cir. March 31, 2008) (explaining that “a flexible TSM [teaching, suggestion, or motivation] test remains the primary guarantor against a non-statutory hindsight analysis”(citations omitted)).

“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. KSR, 127 S.Ct. at 1741. Rather, the KSR Court clarified ways in which a claim could be shown to be nonobvious. In particular, the KSR Court indicated that combining known elements so that the combination yields more than one would expect from such an arrangement would support nonobviousness. Cf., KSR at 1740.

In accordance with the above-outlined KSR approach for supporting nonobviousness, it is respectfully asserted that the combination of limitations claimed by, for example, amended independent Claim 64 yields more than a separate application of those elements. In particular, assuming for the sake of argument only that the pickup date of UPS On Call discloses input of a shipping date, for reasons similar to those given previously above, it is respectfully asserted that the asserted combination of the asserted pickup date of UPS On Call, even if combined with Kara would, at most, provide for input of a pickup date and provide for a calculation of shipping rates for a single pre-selected Kara "urgency." Yet further, because neither the UPS nor the FedEx references even provide for the input of a Pickup (or Shipping) date, for the reasons similarly provided previously above, it is respectfully asserted that combining the UPS or FedEx references with Kara would result in, at most, a calculation of shipping rates for a single pre-selected Kara "urgency." It is respectfully asserted that there is no disclosure in either reference that teaches or suggests the combination of limitations claimed by Claim 64 regarding receiving a set of package specifications and an indication of a shipping date, and then *in response to receiving the set of package specifications and the indication of the shipping date*, transforming the user input into various shipping rates for various delivery services by various carriers according to the shipping date.

It is further respectfully asserted that, in accordance with the above-outlined KSR approach for supporting nonobviousness, the combinations of limitations claimed by, for example, amended dependent Claims 68 and 69, yield more than a separate application of those elements. In particular, even assuming for the sake of argument only as described above that the pickup date of UPS On Call discloses input of a shipping date, it is respectfully asserted that the asserted combination of the asserted pickup date of UPS On Call, even if combined with Kara would, at most, provide for input of a pickup date and provide for a calculation of shipping rates for a single pre-selected "urgency" and would not teach or suggest the combination of limitations claimed by dependent Claim 68 and 69 regarding, for example, identifying days and times by which carriers would deliver a package to a destination, according to a shipping date.

Further, in accordance with the above-outlined KSR approach for supporting nonobviousness, it is respectfully asserted that the combination of limitations claimed by, for example, amended independent Claim 74 yields more than a separate application of those elements. In particular, even assuming for the sake of argument only as described above that the pickup date of UPS On Call discloses input of a shipping date, it is respectfully asserted that the asserted combination of the asserted pickup date of UPS On Call, even if combined with Kara would, at most, provide for input of a pickup date and provide for a calculation of shipping rates for a single pre-selected "urgency" and would not teach or suggest the combination of limitations claimed by Claim 74 regarding, for example, "...transforming an input ... into a first day on which a first carrier would deliver [a] particular package to a particular destination according to a particular shipping date"

For the above-given reasons, it is therefore respectfully asserted that Claims 64, 74, 68 and 69, and therefore dependent Claims 63-67, 70-73 and Claims 75-79 are non-obvious in view of the cited references and are therefore in condition for allowance.

CONCLUSION

For the foregoing reasons and authorities, it is respectfully asserted that the invention disclosed and claimed by Claims 64-79 of the present application are not fairly taught by any of the cited references, taken either alone or in combination, are distinguished from, are not obvious in view of, and are therefore patentable over, the cited references. Accordingly, it is respectfully asserted that the application is condition for allowance. Accordingly, reconsideration and allowance of Claims 64-79 are respectfully requested.

Respectfully submitted,
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